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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,262	04/19/2004	Mao-Sung Chen	547-136A	9411

7590

06/06/2005

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EXAMINER
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JOHNSON, JERROLD D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/826,262	CHEN, MAO-SUNG	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jerrold Johnson	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 sets forth the following paragraph: "said clamping member being made from a material such that said right and left jaw segments are vested with a biasing force that urges said right and left jaw segments towards each other."

This paragraph is confusing. Applicant appears to be setting forth that the jaws of the clamping member are resiliently deformable. Setting forth that the jaws are biased and "urged towards each other", is both confusing and incorrect. No forces urge the jaws toward each other unless they have first been separated.

Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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1. Claim 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Genzel US 5,140,723.

Re claim 1, Genzel in Fig. 3 discloses a clamping type tool bit storage device, comprising: a clamping member including a mount segment which extends angularly about a centerline, and which terminates at right and left lateral ends that are spaced apart from each other by a first length in a longitudinal direction transverse to the centerline, and right and left jaw segments respectively formed with and extending respectively from said right and left lateral ends such that said right and left jaw segments are spaced apart from each other in the longitudinal direction by a second length which is shorter than the first length, said clamping member being made from a material such that said right and left jaw segments are vested with a biasing force that urges said right and left jaw segments towards each other; and a plurality of retaining members 10,12 which are disposed on said mount segment, and which are angularly displaced from one another about the centerline, each of said retaining members being adapted to retain removably a respective one of tool bits, and defining an access line parallel to the centerline such that the respective one of the tool bits retained therein is oriented along the access line.

Genzel does not explicitly disclose a centerline, but inherently includes one within the perimeter of the bracelet. Similarly, Genzel inherently discloses the mount segment and the right and left jaw segments.

Additionally, note the following recitation from column 3, which sets forth the resilient (expandable) property of the Genzel device:

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FIG. 3 illustrates another form of the pen or pencil holder of this invention, where the plate 10 is a portion of a generally oval, expandable member 22 which can function as an arm bracelet. The expandable clips 12 are located on the front of plate 10 as in the previous embodiments. Expandable member 22 can be made of many different types of material, such as metals, polymers, wood, etc. While an expandable member 22 may be preferable for a bracelet, the feature of expandability is not required.

Also, note that the retaining members of Genzel are suitable for use with tool bits, a fact evidenced by Balzano US 5,056,661, herein cited as extrinsic evidence. As the expression "adapted to retain removable a respective one of tool bits" does not confer any structure to the retaining members not disclosed by Genzel, and as Genzel is suitable for this purpose, Genzel anticipates this limitation.

Re claim 2, Genzel inherently discloses that the mount segment has outer and inner wall surfaces opposite to each other radially relative to the centerline.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Genzel in view of Klein US 1,281,025.

Re claim 3, Genzel discloses that each of said retaining members includes a joining portion which is joined to said outer wall surface along a joining line that is

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parallel to the centerline, and which has right and left lateral sides opposite to each other relative to the joining line. Again note the recitation from the Genzel patent excerpted above.

Genzel does not disclose right and left grip portions which respectively extend upwardly from said right and left lateral sides and angularly about the access line to terminate at right and left lateral edges that are spaced apart from each other in the longitudinal direction so as to acquire flexibility in the longitudinal direction.

Klein discloses such grip portions:



It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the clamping tool bit storage device of Genzel with the grip portions at taught by Klein so that a user would not scratch themselves when putting the device on their wrist.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Genzel in view of Winter US 4,606,484 and Geary et al US D371945.

Genzel does not disclose the retaining members having a retaining hole.

Winter discloses in Figs. 4 and 8 the interchangeability of retaining portions having opposing sides (jaws) or holes.

Geary discloses how a plurality of such retaining holes can be disposed angularly about a centerline.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Genzel with holes so as to retain bits in a manner where the bits can not be accidentally knocked off the device.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Genzel in view of Sorkin US 2,824,681 and Propp et al. US 5,538,132.

Genzel does not disclose a magnetically attractive member interposed between said outer and inner wall surfaces and extending angularly about the centerline so as to ensure that the tool bits are retained firmly in said retaining members, respectively.

Sorkin discloses the use of a magnetically attractive member with retaining members (the grooves within the magnet).

Propp discloses the use of magnetically attractive members (magnetic fragments) interposed (embedded) between outer and inner wall surfaces (within the plastic matrix panel). The magnetically attractive members serve to retain tools. See Col 2. line 65 - Col. 3 line 5. See also Col. 3 line 27 which mentions attaching the device to the "wrist."

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Genzel so as to include both retaining members and a magnetically attractive member as taught by Sorkin, and further to have interposed the magnetically attractive member within device between outer and inner wall surfaces as taught by Propp (such as by making the device of Genzel out of plastic and embedding the plastic with magnetically attractive members).

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

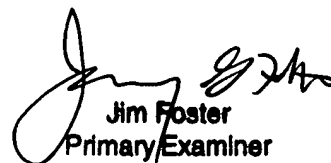
Wilk US 6,129,659 discloses a magnet interposed between surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ

  
Jim Foster  
Primary Examiner  
AU 3728



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